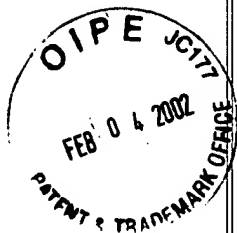


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:

WEITHMANN, Klaus-Ulrich

Application No.: 09/876,091

Filed: June 8, 2001

For: A METHOD FOR DETECTING ACTIVE )  
INGREDIENTS OF MEDICAL VALUE )

) Group Art Unit: 1625  
)  
) Examiner: Ralph J. Gitomer

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

## RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated January 15, 2002, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I: Claims 1-3 drawn to a method to determine an inhibitor;

Group II: Claim 4 drawn to a test kit;

Group III: Claims 5-7 drawn to a compound and composition;

Group IV: Claims 8-16 drawn to a method of treatment; and

Group V: Claim 17 drawn to a substance.

As a preliminary matter, Applicants note that the above grouping of the claims does not acknowledge the Preliminary Amendment filed on July 9, 2001, in which claim 2 was cancelled and claims 1, 4, and 17 were amended.

Therefore, after entering the aforementioned Preliminary Amendment, claims 1, 2, and 4-17 are pending. Accordingly, Group I of the Restriction Requirement would encompass claims 1 and 3 only.

The Restriction Requirement is respectfully traversed. However, to be fully responsive, Applicants provisionally elect, with traverse, the subject matter of Group I, claims 1 and 3.

In the Office Action, the Examiner failed to indicate the reason why the joint examination of claims from Groups I to V would be a serious burden, other than to mention that the inventions are distinct. The Examiner's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for the Examiner to follow in making a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions.**

M.P.E.P. § 803 (emphasis added). Applicants traverse the restriction requirement on the grounds that the Examiner has not shown that there would be a **serious** burden to examine Groups I to V together, despite the statement that a prior art search of these groups includes different areas of classification. Applicants submit that a joint search of at least Groups I and II would not be burdensome because the claims of Group I contain subject matter whose proper search would overlap with the search of Group II. Accordingly, Applicants respectfully request that, at the minimum, the claims of Groups I and II be examined together.

Similarly, an examination of the claims of Group IV would necessarily encompass a search for the claims of Group III, since the compound and compositions of Group III are employed in the methods of treatment of Group IV. Therefore, a joint search of at

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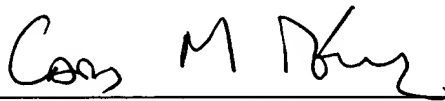
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least Groups III and IV would not be burdensome. Accordingly, Applicants respectfully request that, at the minimum, the claims of Groups of III and IV also be joined in a single group.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
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By:   
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Date: February 4, 2002

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